

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-3, 5, 8-46, and 49 remain in this application. Claims 2, 4, 6, 7, 47 and 48 have been canceled. Claims 9, 10, 13-22 and 31-44 have been withdrawn. Claims 1, 5, 8 and 11 have been amended. Claim 1 has been amended to include the limitations of claims 2, 4 and 7. Claims 5, 8, and 11 have been amended to correct their dependency in light of the cancellation of claims 4 and 7. Accordingly, no new matter has been introduced by this amendment.

II. Restriction Requirement

The Examiner has required restriction under 35 U.S.C. § 121 between the following grouping claims:

- I. Claims 1-30 and 45-49, drawn to a foaming composition, classified in class 510, various subclasses, depending on specific ingredients;
- II. Claims 31-35, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+;
- III. Claims 36-40, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+;
- IV. Claims 41-43, drawn to a method of depositing a benefit agent, classified in class 510, subclass 130+; and
- V. Claim 44, drawn to a method of depositing a benefit agent, classified in class 510, subclass 510.

The Examiner asserts that the inventions are distinct each from the other because allegedly the Inventions of I-V are unrelated. Specifically, the Examiner argues that Groups II and III recited mutually exclusive steps; Groups IV and V recited different ingredients; II and III are drawn to making emulsions; and Groups IV and V are drawn to application of compositions; and Group I does not require the ingredients recited in Groups II-V.

The Examiner has also required further restriction to a specific ester as recited in part a – h of claim 7. Applicants respectfully traverse this requirement. Nevertheless, to be fully responsive Applicants elect pentaerythritol tetraoctanoate as the ester. Applicants respectfully request that the election requirement be expanded to include the a straight-chained or branched C5 to C22 alkyl acid ester of optionally ethoxylated/propoxylated polyols having from about 3 carbon atoms to about 7 carbon atoms. Clearly, a search of the specific esters encompassed by 7b would not be an undue burden on the Examiner.

Applicants respectfully traverse the restriction and apparent election of species requirement for the following reasons. M.P.E.P. § 803 states that the two criteria for a proper requirement for restriction between patentably distinct inventions are 1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is not required. Here, the Examiner has not shown that there would be a serious burden if restriction were not required. Accordingly, Applicants respectfully request the restriction requirement and election requirement be withdrawn, and all pending claims be examined.

III. Claim Rejections – 35 U.S.C. § 112

A. Claims 47 and 48

The Examiner has rejected claims 47 and 48 as indefinite for “merely reciting a use without any active, positive steps delimiting how this use is actually practiced.” Claims 47 and 48 have been canceled. Accordingly, Applicants respectfully request withdrawal of this rejection.

B. Claims 1-3, 6-8, 11, 12, 22-30 and 46-49

The Examiner has rejected claims 1-3, 6-8, 11, 12, 22-30 and 46-49 under 35 U.S.C. § 112, first paragraph because the specification allegedly “does not reasonable provide enablement for any and all conceivable water dispersible components.” Applicants respectfully traverse this rejection. The specification is clearly enabled as it specifically teaches that the term “water dispersible component” shall mean a material that produces a uniform, clear or hazy, mixture when combined with at least a weight equivalent of water.” Specification, page 5, lines 22-25. Nevertheless, solely in an effort to expedite prosecution, Applicants have amended claim 1 to include the limitations of claim 4 as suggested by the Examiner. Accordingly, Applicants respectfully requests withdrawal of this rejection.

C. Claims 1-8, 22-30 and 46-49

The Examiner has rejected claims 1-8, 22-30 and 46-49 under 35 U.S.C. § 112, first paragraph because the specification allegedly “does not reasonable provide enablement for any and all conceivable esters as recited in part b of claim 7.” Applicants respectfully traverse this rejection.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. See M.P.E.P. § 2164.01. Here, the specification clearly teaches suitable esters useful in the present invention. The specification clearly teaches that suitable esters include straight-chained or branched C₅ to C₂₂ alkyl acid esters of optionally ethoxyolated/propoxylated polyols having from about 3 carbon atoms to about 7 carbon atoms. One of ordinary skill in the art could easily determine suitable esters for use in the claimed invention. Applicants submit that the

Examiner has failed to establish a reasonable basis to question the enablement provided for the claimed invention. The minimum requirement is for the examiner to give reasons for the uncertainty of the enablement. See M.P.E.P. § 2164.04 and In re Bowen, 492 F.2d 859, 862-63, 181 USPQ 48,51 (CCPA 1974). Applicants maintain that the claimed invention is fully enabled by the specification and the rejection should be withdrawn.

IV. Double Patenting Rejection

The Examiner has rejected claims 1-8, 11, 12, 22-30 and 45-49 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 23-30 of copending Application No. 09/604,449. Upon indication that the pending claims are allowable, Applicants will file an appropriate terminal disclaimer.

V. Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44 and 46-49 as allegedly unpatentable over U.S. Patent No. 4,980,155 (“Shah et al.”). Applicants respectfully traverse this rejection.

Shah et al. relates to a two phase cosmetic composition including a color phase composition and a gel phase composition which are packaged in side by side separate phases. The cosmetic composition is “one which imparts color to parts of the body, primarily the face. Cosmetic compositions within the contemplation of the present invention include mascara, foundation, eye shadow, blush, brow product and the like.” See col. 2, lines 41-44.

In stark contrast, the present invention relates to **foaming** compositions suitable for use in personal cleansing applications, and in particular make-up removal applications. See Specification, page 1, lines 14-16. Accordingly, the present invention relates to cleansing compositions that remove the very product disclosed by Shah et al. Clearly, Shah et al. fails to render Applicants claimed invention obvious. Specifically, the present invention relates to a **foaming** composition comprising a water dispersible component selected from the group consisting of polyethylene glycol 400, hexylene glycol, propylene glycol, polypropylene glycol-10 methylglucose ether, ethoxydiglycol, polyethylene glycol-6 caprylic/capric glycerides, ethylene glycol monobutyl ether, triisopropyl citrate, polyethylene glycol-8 caprylic/capric glycerides, 3-methoxy-3-methyl-1-butanol, dimethyl isosorbide, polyethylene-6 caprylic/capric triglyceride, and mixtures thereof; an ester; water and a **foaming surfactant**. The foaming surfactant has a column height of greater than about 20 mm as determined by the Miles-Ross Test and is selected from the group consisting of non-ionic surfactants, cationic surfactants, amphoteric surfactants, anionic surfactant, and mixtures thereof. There is no teaching in Shah et al. of

a foaming composition comprising a foaming surfactant. The examiner takes the position that the emulsifiers taught by Shah et al. are similar to foaming surfactants. Applicants respectfully disagree.

Emulsifiers and foaming surfactants are not one in the same. Indeed, Shah et al. specifically teaches that the emulsifiers are present to "disperse the colorant and the film forming agent in water." See col. 3, lines 56-57. In contrast, the foaming surfactants used in Applicants claimed invention are present to create a foaming composition. The emulsifiers taught by Shah et al. are not foaming surfactants. Further, there is nothing in the teachings of Shah et al. that would provide one of ordinary skill in the art to modify the color phase composition of Shah et al. by adding a foaming surfactant in order to arrive at a foaming composition. Accordingly, Applicants respectfully request withdrawal of this rejection.

VI. Conclusion

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding objections and rejections. If the Examiner feels that a discussion with Applicants' representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP-508DIV/EMH. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

By: /Erin M. Harriman/
Erin M. Harriman
Reg. No. 40,410

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-3619
Dated: November 19, 2004